



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,395	03/09/2001	Steven Spielberg	80700.911	7561

22804 7590 05/18/2005

THE HECKER LAW GROUP
1925 CENTURY PARK EAST
SUITE 2300
LOS ANGELES, CA 90067

EXAMINER

HUTTON JR, WILLIAM D

ART UNIT PAPER NUMBER

2179

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/802,395	Applicant(s) SPIELBERG, STEVEN	
	Examiner Doug Hutton	Art Unit 2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

4

Applicant's Response

In Applicant's Response dated 21 January 2005, Applicant amended Claims 1, 5, 11, 18, 31, 32, 46 and 54, and argued against all objections and rejections previously set forth in the Office Action dated 14 July 2004.

All objections previously set forth are withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 5-20, 22-26, 28, 29, 32-34, 36-40, 42, 43, 46-48, 50-54, 56 and 57 remain rejected under 35 U.S.C. 102(e) as being anticipated by Groner, U.S. Patent No. 6,507,643.

Claim 1:

Groner discloses an apparatus for annotating a document (see Figure 11E; see Column 3, Lines 9-12 – Groner discloses this limitation in that the system comprises a text-to-speech converter to read text messages to a caller, who then may edit the messages by speaking into the telephone.), comprising:

- a processor (see Figure 3, element 72);

- memory coupled to said processor (see Figure 3, element 82), said memory comprising at least one text document (see Figure 3, elements 118 and 120);
- a document processing engine configured to obtain said at least one text document from said memory and convert at least a portion of said at least one text document to at least one audio file (see Figure 3; see Column 5, Line 5 through Column 6, Line 51; see Column 10, Lines 19-50 – Groner discloses this limitation in that the system allows the user to review text messages. When the caller opts to review a text message, the dialog manager converts the text messages to audio and plays them to the caller.);
- an audio output device configured to play said at least one audio file to a first user (see Column 10, Lines 19-50 – Groner discloses this limitation in that the system allows a user to call into the messaging system and listen to messages.);
- an audio input device configured to obtain at least one verbalized comment from said user about said at least one audio file wherein said at least one verbalized comment is stored as an audio comment file apart from said at least one audio file (see Column 10, Lines 19-50 – Groner discloses this limitation in that the system allows a user to call into the messaging system, listen to messages and orally edit those messages using a telephone. The caller's oral edits to the messages are saved as files in a voice message storage, thus saving the oral edits in separate files apart from the messages which are saved in a message content storage.);

- an annotator, said annotator configured to associate said audio comment file with a location in said text document that corresponds to said audio file playing when said first user provided said at least one comment (see Column 10, Lines 19-50 – Groner discloses this limitation in that the system saves the caller's verbal edits into the appropriate parts of the text messages. The caller uses the telephone to control the editing of the text messages so that the edits are inserted into the appropriate places.).

Claim 2:

Groner discloses the apparatus of Claim 1, wherein said memory comprises removable media (see Figure 3; see Column 5, Lines 5-30 – Groner discloses this limitation in that the system includes a disk controller and disk drive for storing information to the disk drive. Additionally, the memory of the system may be removed and is thus “removable.”).

Claim 5:

Groner discloses the apparatus of Claim 1, wherein said annotator obtains a start annotation mark from said first user indicating a beginning of said location (see Column 10, Lines 19-50 – Groner discloses this limitation in that the system allows the caller to play the audio file of the message under control of the telephone keypad and to verbally replace words in the message.).

Claim 6:

Groner discloses the apparatus of Claim 5, wherein said annotator obtains an annotation end mark identifying the end of said location (see Column 10, Lines 19-50 – Groner discloses this limitation in that the system allows the caller to play the audio file of the message under control of the telephone keypad and to verbally replace words in the message.).

Claim 7:

Groner discloses an apparatus for annotating a document (see Figure 11E; see Column 3, Lines 9-12 – Groner discloses this limitation in that the system comprises a text-to-speech converter to read text messages to a caller, who then may edit the messages by speaking into the telephone.), comprising:

- a server having a text-to-speech engine configured to obtain at least one text document from memory and convert at least a portion of said at least one text document to at least one audio file (see Figure 3; see Column 5, Line 5 through Column 6, Line 51; see Column 10, Lines 19-50 – Groner discloses this limitation in that the system includes a computer connected to the Internet and allows the user to review text messages. When the caller opts to review a text message, the system converts the text messages to audio and plays them to the caller.);
- a thin-client device configured to obtain said at least one audio file from said server (Groner discloses this limitation in that the system allows a user to call into the messaging system using a telephone.);

- an audio output device configured to play said at least one audio file to a first user, wherein said audio output device is associated with said thin-client (see Column 10, Lines 19-50 – Groner discloses this limitation in that the system allows a user to call into the messaging system and listen to messages.);
- said thin-client device having an audio input element configured to obtain at least one verbalized comment from said user about said at least one audio file, wherein said at least one verbalized comment is transmitted to said server and stored as an audio comment file on said server (see Column 10, Lines 19-50 – Groner discloses this limitation in that the system allows a user to call into the messaging system, listen to messages and orally edit those messages using a telephone. The caller's edits to the messages are saved as a file in the memory of the system.);
- said server having an annotator, said annotator configured to associate said audio comment file with a location in said text document that corresponds to said audio file playing when said first user provided said at least one comment (see Column 10, Lines 19-50 – Groner discloses this limitation in that the system saves the caller's verbal edits into the appropriate parts of the text messages. The caller uses the telephone to control the editing of the text messages so that the edits are inserted into the appropriate places.).

Claim 8:

Groner discloses the apparatus of Claim 7, wherein said thin-client device is connected to said server via an interconnection fabric (see Figure 1).

Claim 9:

Groner discloses the apparatus of Claim 8, wherein said interconnection fabric comprises a telephone network (see Figure 1).

Claim 10:

Groner discloses the apparatus of Claim 9, wherein said interconnection fabric comprises a computer network (see Figure 1).

Claim 11:

Groner discloses the apparatus of Claim 9, wherein said thin-client device comprises a telephone (see Figure 1).

Claim 12:

Groner discloses the apparatus of Claim 9, wherein said audio comment file is stored in at least one associations file (see Column 10, Lines 19-50 – Groner discloses this limitation in that the system includes a voice message storage that stores the caller's oral edits of the message.).

Art Unit: 2179

Claim 13:

Groner discloses the apparatus of Claim 9, wherein said annotator is associated with a Speech Recognition Engine configured to obtain said audio comment file and convert said verbalized comment back to text (see Column 10, Lines 19-50 – Groner discloses this limitation in that the system converts the oral edits made by the caller into text and inserts the edits into the appropriate positions in the text messages.).

Claim 14:

Groner discloses the apparatus of Claim 9, wherein said server comprises a voice command interface (see Column 2, Lines 12-15 – Groner discloses this limitation in that the system includes a server and indicates that the prior art includes voice command interfaces for messaging systems.).

Claim 15:

Groner discloses the apparatus of Claim 9, wherein said server is configured to mark the beginning of said verbalized comment upon receipt of a start annotation mark (see Column 10, Lines 19-50 – Groner discloses this limitation in that the system allows the caller to play the audio file of the message under control of the telephone keypad and to verbally replace words in the message.).

Claim 16:

Groner discloses the apparatus of Claim 15, wherein said server is configured to mark the end of said verbalized comment upon receipt of an end annotation mark (see Column 10, Lines 19-50 – Groner discloses this limitation in that the system allows the caller to play the audio file of the message under control of the telephone keypad and to verbally replace words in the message.).

Claim 17:

Groner discloses the apparatus of Claim 16, wherein said audio comment file comprises data recorded by said server between receipt of said start annotation mark and said end annotation mark (see Column 10, Lines 19-50 – Groner discloses this limitation in that the system records the oral edits made by the caller in the voice message storage.).

Claim 18:

Groner discloses a method for annotating a document (see Figure 11E; see Column 3, Lines 9-12 – Groner discloses this limitation in that the system comprises a text-to-speech converter to read text messages to a caller, who then may edit the messages by speaking into the telephone.), comprising:

- obtaining a pre-existing document from a memory medium via an interconnection path configured to access said document (see Figure 3; see Column 5, Line 5 through Column 6, Line 51; see Column 10, Lines 19-50 – Groner discloses this

limitation in that the system includes a computer connected to the Internet and allows the user to review and edit text messages. The text messages are recorded and stored in message content storage before the user accesses those messages for editing. Thus, the messages are "pre-existing.");

- converting said document to audio elements (see Figure 3; see Column 5, Line 5 through Column 6, Line 51; see Column 10, Lines 19-50 – Groner discloses this limitation in that the system allows the user to review text messages. When the caller opts to review text messages, the system converts the text messages to audio and plays them to the caller.);
- presenting an audible playback of said audio elements to a user when said user indicates a desire to hear said document (see Column 10, Lines 19-50 – Groner discloses this limitation in that the system allows a user to call into the messaging system and listen to messages.);
- obtaining verbalized comments comprising annotations to said document, said verbalized comments obtained from said user via an audio input mechanism upon receipt of an annotation start mark during said audible playback (see Column 10, Lines 19-50 – Groner discloses this limitation in that the system allows a user to call into the messaging system, listen to messages by playing those messages under control of the telephone keypad and orally edit those messages using a telephone. The oral edits are stored in a voice message storage that is separate from the message content storage.);

- associating said verbalized comments with a location in said document corresponding with the occurrence of said annotation start mark during said audible playback (see Column 10, Lines 19-50 – Groner discloses this limitation in that the system saves the caller's verbal edits into the appropriate parts of the text messages. The caller uses the telephone to control the editing of the text messages so that the edits are inserted into the appropriate places.).

Claim 19:

Groner discloses the method of Claim 18, wherein said document comprises text data (see Column 10, Lines 19-50 – Groner discloses this limitation in that the system allows the user to review text messages.).

Claim 20:

Groner discloses the method of Claim 18, wherein said memory medium comprises removable media (see Figure 3; see Column 5, Lines 5-30 – Groner discloses this limitation in that the system includes a disk controller and disk drive for storing information to the disk drive. Additionally, the memory of the system may be removed and is thus "removable.").

Claim 22:

Groner discloses the method of Claim 20, wherein said interconnection path comprises a network (see Figure 3; see Column 5, Line 5 through Column 6, Line 51;

Art Unit: 2179

see Column 10, Lines 19-50 – Groner discloses this limitation in that the system includes a computer connected to the Internet and allows the user to review text messages. When the caller opts to review a text message, the system converts the text messages to audio and plays them to the caller.).

Claim 23:

Groner discloses the method of Claim 20, wherein said network comprises a wireless network (Groner discloses this limitation in that the system comprises a telephone and the prior art includes wireless phones.).

Claim 24:

Groner discloses the method of Claim 20, wherein said network comprises a telephone network (see Figure 1).

Claim 25:

Groner discloses the method of Claim 24, wherein said telephone network comprises a cellular network (As indicated in the above rejection for Claim 23, Groner discloses this limitation.).

Claim 26:

Groner discloses the method of Claim 18, wherein a document processing engine performs said converting step (Groner discloses this limitation in that the text messages are processed by converting them to audio.).

Claim 28:

Groner discloses the method of Claim 18, wherein said converting said document to audio elements occurs at a server (Groner discloses this limitation in that the system allows the caller to call into the system and convert text messages to audio, wherein all of the processing is done at the server.).

Claim 29:

Groner discloses the method of Claim 28, wherein said server generates an audio file associated with said presenting said audible playback of said audio elements (see Column 10, Lines 19-50 – Groner discloses this limitation in that the system stores the voice messages and oral edits in audio files in the voice message storage.).

Claim 32:

Groner discloses a method for annotating a document (see Figure 11E; see Column 3, Lines 9-12 – Groner discloses this limitation in that the system comprises a text-to-speech converter to read text messages to a caller, who then may edit the messages by speaking into the telephone.), comprising:

- obtaining a document from a memory medium via an interconnection path configured to access said document, said document having text elements (see Figure 3; see Column 5, Line 5 through Column 6, Line 51; see Column 10, Lines 19-50 – Groner discloses this limitation in that the system includes a computer connected to the Internet and allows the user to review and edit text messages.);
- obtaining from an annotations file a first annotation of said text document, said first annotation having a first set of audio elements (see Column 10, Lines 19-50 – Groner discloses this limitation in that the system allows a user to call into the messaging system and orally edit those messages using a telephone. These oral edits are stored in a voice message storage.);
- converting said text elements to a second set of audio elements (see Figure 3; see Column 5, Line 5 through Column 6, Line 51; see Column 10, Lines 19-50 – Groner discloses this limitation in that the system allows the user to review text messages that were previously edited by the caller. When the caller opts to review text messages, the system converts the text messages to audio and plays them to the caller.);
- associating said first set of audio elements with said second set of audio elements to generate a playback document (see Column 10, Lines 19-50 – Groner discloses this limitation in that the system converts text messages that were previously edited by the caller and plays those messages to the caller using a telephone.);

- generating an audible playback of said playback document to a user when said user indicates a desire to hear said document (see Column 10, Lines 19-50 – Groner discloses this limitation in that the system allows a user to call into the messaging system and listen to messages.);
- obtaining verbalized comments from said user via an audio input mechanism upon activation of an annotation trigger during said audible playback (see Column 10, Lines 19-50 – Groner discloses this limitation in that the system allows a user to call into the messaging system, listen to messages by playing those messages under control of the telephone keypad and orally re-edit those messages using a telephone. The user may re-edit the messages as often as he wants.);
- associating said verbalized comments with a location in said playback document corresponding with the occurrence of said annotation trigger during said audible playback (see Column 10, Lines 19-50 – Groner discloses this limitation in that the system saves the caller's verbal edits into the appropriate parts of the text messages. The caller uses the telephone to control the editing of the text messages so that the edits are inserted into the appropriate places.).

Claim 33:

Groner discloses the method of Claim 32, wherein said document comprises text data (see Column 10, Lines 19-50 – Groner discloses this limitation in that the system allows the user to review text messages.).

Art Unit: 2179

Claim 34:

Groner discloses the method of Claim 32, wherein said memory medium comprises removable media (see Figure 3; see Column 5, Lines 5-30 – Groner discloses this limitation in that the system includes a disk controller and disk drive for storing information to the disk drive. Additionally, the memory of the system may be removed and is thus “removable.”).

Claim 36:

Groner discloses the method of Claim 32, wherein said interconnection path comprises a network (see Figure 3; see Column 5, Line 5 through Column 6, Line 51; see Column 10, Lines 19-50 – Groner discloses this limitation in that the system includes a computer connected to the Internet and allows the user to review text messages. When the caller opts to review a text message, the system converts the text messages to audio and plays them to the caller.).

Claim 37:

Groner discloses the method of Claim 36, wherein said network comprises a wireless network (Groner discloses this limitation in that the system comprises a telephone and the prior art includes wireless phones.).

Claim 38:

Groner discloses the method of Claim 36, wherein said network comprises a telephone network (see Figure 1).

Claim 39:

Groner discloses the method of Claim 38, wherein said telephone network comprises a cellular network (As indicated in the above rejection for Claim 37, Groner discloses this limitation.).

Claim 40:

Groner discloses the method of Claim 32, wherein a document processing engine performs said converting step (Groner discloses this limitation in that the text messages are processed by converting them to audio.).

Claim 42:

Groner discloses the method of Claim 32, wherein said converting said document to audio elements occurs at a server (Groner discloses this limitation in that the system allows the caller to call into the system and convert text messages to audio, wherein all of the processing is done at the server.).

Art Unit: 2179

Claim 43:

Groner discloses the method of Claim 42, wherein said server generates an audio file associated with said presenting said audible playback of said audio elements (see Column 10, Lines 19-50 – Groner discloses this limitation in that the system stores the voice messages and oral edits in audio files in the voice message storage.).

Claim 46:

Groner discloses a method for annotating a document (see Figure 11E; see Column 3, Lines 9-12 – Groner discloses this limitation in that the system comprises a text-to-speech converter to read text messages to a caller, who then may edit the messages by speaking into the telephone.), comprising:

- generating authentication information of a user desiring access to a pre-existing document (see Figure 3; see Column 5, Line 5 through Column 6, Line 51; see Column 10, Lines 19-50 – Groner discloses this limitation in that the system includes a computer connected to the Internet and allows the user to review and edit text messages. The text messages are recorded and stored in message content storage before the user accesses those messages for editing. Thus, the messages are “pre-existing.” Also, the system determines whether the caller is a subscriber to the messaging system and thus authenticates the user.);
- allocating an associations file structure for said user (see Column 6, Lines 53-64 – Groner discloses this limitation in that the system the system generates a message header data structure to identify the caller.);

- obtaining said document from a memory medium via an interconnection path configured to access said document, said document having text elements (see Figure 3; see Column 5, Line 5 through Column 6, Line 51; see Column 10, Lines 19-50 – Groner discloses this limitation in that the system includes a computer connected to the Internet and allows the user to review and edit text messages.);
- obtaining a first pre-existing annotation of said document, said first pre-existing annotation having a first set of audio elements (see Column 10, Lines 19-50 – Groner discloses this limitation in that the system allows a user to call into the messaging system and orally edit those messages using a telephone. These oral edits are stored in a voice message storage.);
- converting said text elements to a second set of audio elements (see Figure 3; see Column 5, Line 5 through Column 6, Line 51; see Column 10, Lines 19-50 – Groner discloses this limitation in that the system allows the user to review text messages that were previously edited by the caller. When the caller opts to review text messages, the system converts the text messages to audio and plays them to the caller.);
- associating said first set of audio elements with said second set of audio elements to generate a playback document (see Column 10, Lines 19-50 – Groner discloses this limitation in that the system converts text messages that were previously edited by the caller and plays those messages to the caller using a telephone.);

- generating an audible playback of said playback document to said user when said user indicates a desire to hear said document (see Column 10, Lines 19-50 – Groner discloses this limitation in that the system allows a user to call into the messaging system and listen to messages.);
- obtaining verbalized comments from said user via an audio input mechanism upon activation of an annotation trigger during said audible playback, said verbalized comments comprising a second annotation of said document (see Column 10, Lines 19-50 – Groner discloses this limitation in that the system allows a user to call into the messaging system, listen to messages by playing those messages under control of the telephone keypad and orally re-edit those messages using a telephone. The user may re-edit the messages as often as he wants.);
- associating said verbalized comments with a location in said playback document corresponding with the occurrence of said annotation trigger during said audible playback (see Column 10, Lines 19-50 – Groner discloses this limitation in that the system saves the caller's verbal edits into the appropriate parts of the text messages. The caller uses the telephone to control the editing of the text messages so that the edits are inserted into the appropriate places.); and
- storing said location and said authentication information of said user and said verbalized comments in said associations file structure (see Column 10, Lines 19-50 – Groner discloses this limitation in that the system stores the message

header data structure and the caller's verbalized re-edits and incorporates them into the appropriate parts of the text messages.).

Claim 47:

Groner discloses the method of Claim 46, wherein said document comprises text data (see Column 10, Lines 19-50 – Groner discloses this limitation in that the system allows the user to review text messages.).

Claim 48:

Groner discloses the method of Claim 46, wherein said memory medium comprises removable media (see Figure 3; see Column 5, Lines 5-30 – Groner discloses this limitation in that the system includes a disk controller and disk drive for storing information to the disk drive. Additionally, the memory of the system may be removed and is thus “removable.”).

Claim 50:

Groner discloses the method of Claim 48, wherein said interconnection path comprises a network (see Figure 3; see Column 5, Line 5 through Column 6, Line 51; see Column 10, Lines 19-50 – Groner discloses this limitation in that the system includes a computer connected to the Internet and allows the user to review text messages. When the caller opts to review a text message, the system converts the text messages to audio and plays them to the caller.).

Claim 51:

Groner discloses the method of Claim 50, wherein said network comprises a wireless network (Groner discloses this limitation in that the system comprises a telephone and the prior art includes wireless phones.).

Claim 52:

Groner discloses the method of Claim 50, wherein said network comprises a telephone network (see Figure 1).

Claim 53:

Groner discloses the method of Claim 52, wherein said telephone network comprises a cellular network (As indicated in the above rejection for Claim 51, Groner discloses this limitation.).

Claim 54:

Groner discloses the method of Claim 46, wherein a document processing engine performs said converting step (Groner discloses this limitation in that the text messages are processed by converting them to audio.).

Claim 56:

Groner discloses the method of Claim 46, wherein said converting said document to audio elements occurs at a server (Groner discloses this limitation in that the system

allows the caller to call into the system and convert text messages to audio, wherein all of the processing is done at the server.).

Claim 57:

Groner discloses the method of Claim 56, wherein said server generates an audio file associated with said presenting said audible playback of said audio elements (see Column 10, Lines 19-50 – Groner discloses this limitation in that the system stores the voice messages and oral edits in audio files in the voice message storage.).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 30, 31, 44, 45, 58 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Groner.

Claims 30, 44 and 58:

As indicated in the above rejection, Groner discloses every element of Claims 18, 32 and 46.

Groner fails to expressly disclose converting said document to audio elements at a client. However, it would have been obvious to one of ordinary skill in the art at the

Art Unit: 2179

time the invention was made to have invoked the text-to-speech conversion process at a client for the purpose of editing the text and voice messages at the caller's telephone to conserve bandwidth at the server. At the time the invention was made, it would have been obvious to one of ordinary skill in the art that the text-to-speech conversion process could have occurred at either the client or the server. Whether the text-to-speech conversion took place at the client or the server was strictly a design choice made by the programmer.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the messaging system, disclosed in Groner, to include converting said document to audio elements at a client for the purpose of editing the text and voice messages at the caller's telephone to conserve bandwidth at the server.

Claims 31, 45 and 59:

As indicated in the above rejection, Groner discloses/teaches every element of Claims 29, 44 and 58.

Groner fails to expressly disclose generating an audio file associated with said presenting said audible playback of audio elements at a client. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have generated an audio file associated with said presenting said audible playback of audio elements at a client for the purpose of editing the text and voice messages at the caller's telephone to conserve bandwidth at the server. At the time the invention was

made, it would have been obvious to one of ordinary skill in the art that the generation of the audio file could have occurred at either the client or the server. Whether the generation of the audio file took place at the client or the server was strictly a design choice made by the programmer.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the messaging system, disclosed in Groner, to include generating an audio file associated with said presenting said audible playback of audio elements at a client for the purpose of editing the text and voice messages at the caller's telephone to conserve bandwidth at the server.

Claims 3, 21, 35 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Groner, in view of Merrill et al., U.S. Patent No. 6,181,351.

Claims 3, 21, 35 and 49:

As indicated in the above rejection, Groner discloses every element of Claims 2, 20, 34 and 48.

Groner fails to expressly disclose a removable memory comprising flash memory.

Merrill teaches an annotator (see Column 7, Lines 12-15 – Merrill discloses this limitation in that the system is used to annotate a speech sound data stream.) having removable memory that comprises flash memory (see Column 5, Lines 32-37 – Merrill discloses this limitation in that the system comprises many different types of computer

memory, including flash memory.) for the purposes of recording, storing and editing audio files (see Column 9, Lines 20-51).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus/method, disclosed in Groner, to include removable memory that comprises flash memory for the purpose of recording, storing and editing audio files, as taught by Merrill.

Claims 4, 27, 41 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Groner, in view of Gupta et al., U.S. Patent Application Publication No. US 2003/0196164 A1.

Claim 4:

As indicated in the above rejection, Groner discloses every element of Claim 1.

Groner fails to expressly disclose an audio file comprising a streaming media file.

Gupta teaches a system/method for annotating a document (see Figure 1; see Paragraph 0001 – Gupta discloses this limitation in that the system includes annotations to corresponding media content.) that includes an audio file comprising a streaming media file (see Paragraph 0027 – Gupta discloses this limitation in that the system accesses audio files that are streaming media files) for the purpose of providing the audio file to a client user on a real-time, as-needed basis (see Paragraph 0005).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus/method, disclosed in Groner,

to include an audio file comprising a streaming media file for the purpose of providing the audio file to a client user on a real-time, as-needed basis, as taught by Gupta.

Claims 27, 41 and 55:

As indicated in the above rejection, Groner discloses every element of Claims 26, 40 and 46.

Groner fails to expressly disclose a document processing machine that optimizes said audio elements.

Gupta teaches a method for annotating a document (see Figure 1; see Paragraph 0001 – Gupta discloses this limitation in that the system includes annotations to corresponding media content.) that includes a document processing machine that optimizes said audio elements (see Paragraphs 0049-0057 – Gupta discloses this limitation in that the system includes a media server that processes an audio file by dropping short segments from the speech signal at regular intervals and performing cross fading or smoothing between adjacent segments.) for the purpose of improving the resulting sound quality of the audio file (see Paragraph 0053).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Groner, to include a document processing machine that optimizes said audio elements for the purpose of improving the resulting sound quality of the audio file, as taught by Gupta.

Response to Arguments

Applicant's arguments filed 21 January 2005 have been fully considered but they are not persuasive.

Arguments for Claims 1 and 7:

Applicant argues that Groner fails to disclose a comment ***about*** an audio file because the Groner is a voicemail system and the caller is not making a comment but rather directly modifying the audio files. See *Applicant's Response* – Page 21, first full paragraph through Page 22, first partial paragraph.

The examiner disagrees.

Groner allows a caller to dictate a message into the system. As the caller dictates the message, the system converts the caller's oral message into text. The caller may elect to review and edit the text message. By editing the text message, the caller orally makes an comment ***about*** the textual message in that the caller indicates a desire to modify the message. That is, by modifying the message, the caller is commenting ***about*** the message.

Applicant argues that Groner fails to disclose storing at least one verbalized comment as an audio comment file apart from said at least one audio file because Groner creates a modified voice message and a modified text message of the same content. See *Applicant's Response* – Page 22, first full paragraph through Page 23, first partial paragraph.

The examiner disagrees.

The relevant claim language is: “an audio input device configured to obtain at least one verbalized comment from said user about said at least one audio file wherein said at least one verbalized comment is stored as an audio comment file apart from said at least one audio file” (see Claim 1, Lines 11-14).

Firstly, this limitation recites no language regarding whether the content of the “verbalized comment” and the “audio file” are the same or are different. Secondly, Groner discloses that the “verbalized comment” is stored in the voice message storage (see Column 10, Lines 20-22) and the audio file is stored in the message content storage (see Column 10, Lines 24-28). Accordingly, Groner discloses that the “verbalized comment” file is stored apart from the “audio file.”

Applicant argues that Groner fails to disclose associating an audio comment file with a location in said text document. See *Applicant's Response* – Page 23, first full paragraph.

The examiner disagrees.

The relevant claim language is: “an annotator, said annotator configured to associate said audio comment file with a location in said text document that corresponds to said audio file playing when said first user provided said at least one comment” (see Claim 1, Lines 15-17).

Firstly, the examiner notes that this limitation is broadly worded in that “associating” one computer file “with” another computer file hardly limits the scope of the claim. Secondly, as previously indicated, Groner discloses a “verbalized comment” that is stored as an audio file in the voice message storage and a textual message that is stored as a text file in the message content storage. When a caller edits a previously recorded textual message, the caller’s oral edits are stored as an audio file in the voice message storage, converted into text and incorporated into an edited textual message, which is stored as a text file in the message content storage. Accordingly, the caller’s oral edits are “associated with” a location in the edited textual message in that the content of the oral edits replaces some of the original content of the textual message.

Arguments for Claim 18:

Applicant argues that Groner fails to disclose obtaining a pre-existing document because the voice message and text message are created when the user calls the voicemail system. See *Applicant’s Response* – Page 27, second full paragraph.

The examiner disagrees.

Groner discloses a system that allows a caller to review and edit text messages that were previously recorded by the caller, converted into text and stored in the message content storage. When the caller opts to edit the message, the textual message is obtained from the message content storage, converted into an audio file

and played to the caller. See Column 10, Lines 19-50. Accordingly, Groner discloses “obtaining a pre-existing document.”

Arguments for Claim 32:

Applicant argues that Groner fails to disclose obtaining a first annotation of the document from an annotations file because Groner does not teach or suggest an annotations file. See *Applicant’s Response* – Page 30, second full paragraph.

The examiner disagrees.

Groner discloses an annotations file in that the caller’s oral edits are stored as an audio file in the message content storage. This audio file comprises an annotations file. The caller may opt to review and edit the textual message multiple times. See Column 10, Lines 49-50. Each time the user re-edits the message, the textual message has been obtained from memory, converted to audio and associated with the caller’s previous edits. Accordingly, Groner discloses “obtaining a first annotation of the document from an annotations file.”

Applicant argues that Groner fails to disclose verbalized comments comprising a second annotation because Groner does not obtain annotations since the verbalized information is either the originally obtained voice message or a modified voice message. See *Applicant’s Response* – Page 31, first paragraph.

The examiner disagrees.

As previously indicated, the caller may opt to review and edit the textual message multiple times. By re-editing the textual message, the caller orally makes an comment **about** the textual message in that the caller indicates a desire to modify the message. That is, by modifying the message, the caller is commenting **about** the message. Thus, the caller's oral re-edits comprise a "second annotation."

Arguments for Claim 46:

Applicant argues that Groner fails to disclose generating authentication information of a user desiring access to a pre-existing document because Groner does not teach or suggest a user desiring access to a pre-existing document. See *Applicant's Response* – Page 34, first full paragraph.

The examiner disagrees.

The system disclosed in Groner relates generally to a combination of voice and electronic mail messaging. The system requires that a user be a subscriber before the user is granted access to the electronic mail portion of the system. See Column 5, Lines 43-50. In typical electronic mail systems, a user may generate and store messages to be sent at a later time. Groner expressly discloses that the caller's verbal messages are converted to text and stored. See Column 10, Lines 19-28. Groner also discloses that the caller may edit the textual message and indicate to the system that the message is ready to send. See Column 10, Lines 29-53. The user may elect to store the message to be sent at a later time. At that time, the user would then log on to

the system and indicate his desire to send the message. Also, the user may elect to edit the message before sending it. Accordingly, Groner discloses "generating authentication information of a user desiring access to a pre-existing document."

Applicant argues that Groner fails to disclose obtaining a first pre-existing annotation of said document because Groner provides no annotation capability and therefore no access to pre-existing annotations. Rather, Applicant argues, Groner is directed only to processing current voice messages. See *Applicant's Response* – Page 34, second full paragraph through Page 35, first partial paragraph.

The examiner disagrees.

As previously indicated, Groner discloses "annotation capability." Groner also discloses access to "pre-existing annotations" in that the user may opt to re-edit textual messages that were previously edited. The previously edited messages include "annotations" that have already been incorporated into the message. Finally, Groner is not limited to processing current voice messages, as indicated in the immediately above discussion.

Applicant argues that Groner fails to disclose associating said first set of audio elements with said second set of audio elements to generate a playback document because the voice message in Groner does not arise in audio elements from a pre-existing document or a pre-existing annotation of the document. See *Applicant's Response* – Page 35, first full paragraph.

The examiner disagrees.

This argument is a combination of arguments previously submitted for Claims 1 ("associating with" argument), 18 ("pre-existing" argument) and 32 ("annotation" argument). Thus, the examiner's response to these arguments have already been set forth.

Applicant argues that Groner fails to disclose storing said location and said authentication information of said user and said verbalized comments in said associations file structure because the email header in Groner does not include "verbalized comments that comprise annotations of a pre-existing document" and does not comprise a location of the playback file associated with the verbalized comments. See *Applicant's Response* – Page 35, third full paragraph through Page 36, first partial paragraph.

The examiner disagrees.

Again, Applicant's arguments concerning "annotations" and "pre-existing documents" have already been addressed. Also, the email header in Groner does include "verbalized comments that comprise annotations of a pre-existing document" in that the header is part of the email message that is generated by the system. As previously indicated, Groner discloses a typical email system which stores message drafts and sent messages.

In response to Applicant's argument that Groner fails to disclose "a location of the playback file associated with the verbalized comments" (emphasis added), it is

noted that this feature is not recited in the rejected claim. Instead, Claim 46 recites "associating said verbalized comments with a location in said playback document corresponding with the occurrence of said annotation trigger during said audible playback" (emphasis added). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doug Hutton whose telephone number is (571) 272-


Art Unit: 2179

4137. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

WDH
may 15, 2005


HEATHER R. HERNDON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100